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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,585	11/14/2003	Brian K. Hollowell	1033-MS1008	1674
34456	7590	07/28/2005	EXAMINER	
TOLER & LARSON & ABEL L.L.P. 5000 PLAZA ON THE LAKE STE 265 AUSTIN, TX 78746			ESCALANTE, OVIDIO	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,585

Applicant(s)

HOLLOWELL ET AL.

Examiner

Ovidio Escalante

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/14/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4,6-9,11-17,19,21-27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Tverskoy et al. US Patent 6,341,160.

Regarding claims 1 and 29, Tverskoy teaches a messaging method (abstract) and a computer-readable medium having computer-readable data comprising:

receiving an indication of a call from a calling party to a called party, (col. 3, lines 13-20);

answering the call at a premises of the called party; prompting the calling party to leave a message, (col. 3, lines 20-21);

saving at least a portion of the message as an audio file, (col. 3, lines 26-29);

recognizing that the calling party left the message, (col. 3, lines 56-62);

preparing an outgoing message in response to recognizing that the calling party left the message, (col. 4, line 62-col. 5, line 13);

attaching the audio file to the outgoing message, (col. 4, lines 2-9);

addressing the outgoing message to a network node associated with a unified messaging mailbox of the called party, (col. 4, line 62-col. 5, line 13); and

initiating sending of the message and the audio file from the premises to the network node, (col. 5, lines 24-30).

Regarding claim 2, Tverskoy, as applied to claim 1, teaches disconnecting from the call, (col. 3, lines 29-31);

prompting a modem to dial a telephone number associated with an Internet Service Provider, (col. 4, lines 14-22; col. 8, lines 24-34);

recognizing that a connection exists with the Internet Service Provider, (col. 4, lines 14-22); and

outputting information representing the outgoing message for delivery via the connection, (col. 4, line 62-col. 5, line 13).

Regarding claim 3, Tverskoy, as applied to claim 2, teaches outputting a username and password to the Internet Service Provider to gain access to an account of the called party, (col. 4, lines 14-23).

Regarding claim 4, Tverskoy, as applied to claim 1, teaches maintaining a notification list including at least one calling party, (col. 3, lines 34-46);

receiving identification information associated with the call and identifying the calling party, (col. 3, lines 32-39); and determining that the calling party is the at least one calling party, (col. 3, lines 32-46).

Regarding claim 6, Tverskoy, as applied to claim 1, teaches wherein the outgoing message has a format of an electronic mail message format, (col. 4, line 62-col. 5, line 13).

Regarding claim 7, Tverskoy, as applied to claim 1, teaches utilizing a modem device to send the outgoing message, wherein the modem device is a cable modem, a dial-up modem, (col. 8, lines 24-34).

Regarding claim 8, Tverskoy, as applied to claim 1, teaches determining that a data connection exists, (col. 4, lines 24-32); and

utilizing the data connection to send the outgoing message, (col. 5, lines 24-30).

Regarding claim 9, Tverskoy, as applied to claim 1, teaches wherein the message comprises a multi-modal message having an audio component and a non-audio component, (col. 5, lines 2-24).

Regarding claim 11, Tverskoy teaches a messaging system, (abstract), comprising:
a housing component (12) at least partially defining an enclosure, (fig. 1);
a network interface (18) operable to form at least a portion of a communication link between remote node of a network (ISP 30) and a component located within the enclosure, (fig. 1);

a call awareness trigger communicatively coupled to the network interface and operable to recognize a signal indicating an incoming call from a calling party, (col. 3, lines 13-20);

a call answering mechanism operable to answer the incoming call and to prompt the calling party to leave a message, (col. 3, lines 20-25);

a memory operable to store an audio file representing the message, (col. 3, lines 26-29);

a messaging engine operable to compose an outgoing message, to attach the audio file to the outgoing message, and to initiate communication of the outgoing message to a remote messaging server, (col. 4, line 62-col. 5, line 13,24-30).

Regarding claim 12, Tverskoy, as applied to claim 11, teaches wherein the call awareness trigger, the call answering mechanism, the memory, and the messaging engine are located within the enclosure, further wherein the call awareness trigger recognizes a ring voltage signal, (fig. 1; col. 3, lines 13-20).

Regarding claim 13, Tverskoy, as applied to claim 11, teaches a computer having a housing comprising the housing component, (fig. 1).

Regarding claim 14, Tverskoy, as applied to claim 11, teaches a telephone station communicatively coupled to a jack associated with the housing component; and a modem communicatively coupled to the network interface, (fig. 1; col. 4, lines 14-22; col. 8, lines 24-34).

Regarding claim 15, Tverskoy, as applied to claim 11, teaches a processor (26) located within the enclosure, the processor operable to execute instructions to effectuate the messaging engine, (col. 4, line 62-col. 5, lines 2-9).

Regarding claim 16, Tverskoy, as applied to claim 11, teaches a computer jack associated with the housing component, the computer jack operable to interconnect a computer (34) with the component; and a processor located within the enclosure, (fig. 1).

Regarding claim 17, Tverskoy, as applied to claim 16, teaches a computer readable medium having computer-readable data to allow the computer to store a username and password in the memory, to indicate a messaging address for an intended recipient of the outgoing message, and to indicate an identifier for the remote messaging server, (fig. 1).

Regarding claim 19, Tverskoy, as applied to claim 11, teaches a broadband modem communicatively coupled to the network interface, the broadband modem operable to support an always-on connection to a broader network, (col. 8, lines 24-34).

Regarding claim 21, Tverskoy teaches a method of facilitating unified messaging, (abstract), comprising:

communicatively coupling a messaging device to a premises network communicatively coupled to a wide-area communication network (Internet), (fig. 1);

communicatively coupling a telephone station at the premises to the messaging device, (fig.1);

communicatively coupling a computer to the messaging device (fig. 1);

employing the messaging device to answer an incoming telephone call from a calling party, (col. 3, lines 13-20), to play a pre-recorded message that prompts the calling party to leave a message, (col. 3, lines 21-25), to record a voice message from the calling party, (col. 3, lines 21-29), to compose an electronic mail message in response to the voice message, (col. 4, line 62-col. 5, line 13), to attach an audio file representing the voice message to the electronic mail message, and to initiate sending of the electronic mail message via the wide-area communication network, (col. 4, line 62-col. 5, line 13,24-30).

Regarding claim 22, Tverskoy, as applied to claim 21, teaches executing code directing the computer to store a username and password in a memory associated with the messaging device, to indicate a messaging address for an intended recipient of the electronic mail message, and to indicate an identifier for a remote messaging server communicatively coupled to the wide-area network, (col. 4, lines 14-23).

Regarding claim 23, Tverskoy, as applied to claim 21, teaches determining that a data connection exists interconnecting the premises network and a node of the wide-area network; and utilizing the data connection to send the electronic mail message, (col. 4, lines 14-23).

Regarding claim 24, Tverskoy, as applied to claim 21, teaches disconnecting from the incoming telephone call, (col. 3, lines 29-31);

prompting a modem to dial a telephone number associated with an Internet Service Provider, (col. 4, lines 14-22; col. 8, lines 24-34);

recognizing that a connection exists with the Internet Service Provider, (col. 4, lines 14-22); and

utilizing the connection to send the electronic mail message, (col. 5, lines 24-30).

Regarding claim 25, Tverskoy, as applied to claim 21, teaches wherein the audio file is a WAV file, (col. 4, line 62-col. 5, line 13).

Regarding claim 26, Tverskoy, as applied to claim 21, teaches addressing the electronic mail message to more than one intended recipient, (col. 5, lines 24-30).

Regarding claim 27, Tverskoy, as applied to claim 21, teaches attaching a second file to the electronic mail message comprising non-audio information communicated by the calling party, (col. 4, line 62-col. 5, line 13).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 5,10,18,20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tverskoy in view of Alexis US Patent Pub 2004/0072544.

Regarding claims 5,10,18, 20 and 28, Tverskoy, as applied to claim 1, does not specifically teach wherein the call comprises a Voice over Internet Protocol call.

In the same field of endeavor, Alexis teaches wherein a call can comprises a Voice over Internet Protocol call, (paragraphs 0045 and 0051). Alexis also teaches converting the audio file into an uuencoded text format, (paragraphs 0166 and 0172) and a computer jack comprises a universal serial bus port, (paragraph 0092 and 0146).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tverskoy by providing Voice over Internet Protocol calls as taught by Alexis so that cost for the call can be lowered when compared with conventional telephone calls.

Conclusion

7. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7537, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8000.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OVIDIO ESCALANTE
PATENT EXAMINER

Ovidio Escalante

Ovidio Escalante
Examiner
Group 2645
July 14, 2005

O.E./oe